

REMARKS***Summary of the Response***

By the present amendment claims 1 – 10 have been canceled and new claims 11 – 19 have been presented for examination. Accordingly, claims 11 – 19 remain pending. Applicant submits no new matter has been added by the present amendment. Support for the amendment may be found at least in original claims 1 – 10. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected claims 1, 3 and 5 – 8¹ over the art of record and objected to claims 2, 4, 9 and 10. By the present remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Allowable Subject Matter

Applicant appreciates the indication that claims 2, 4, 9 and 10 contain allowable subject matter and would be allowable if rewritten into independent form including all of the limitations of the base claim and any intervening claims. By the present amendment, Applicant has presented new claim 11, which contains the features of original claims 1 and 2, has presented new claim 18, which contains the features of original claim 1 and previously presented claim 4, and has presented new claim 19, which contains the features of original claim 1 and previously

¹ Applicant notes that the Examiner has indicated claims 1, 3 and 5 – 8 are rejected on the Office Action Summary. However, in the statement of rejection under § 102, the Examiner indicated that claims 1 – 10 are rejected under § 102. The body of the rejection under § 102, however, only addresses the features of claims 1, 3, 5 and 6. As such, Applicant assumes that the Examiner incorrectly indicated that claims 1 – 10 are rejected under § 102 in the statement of rejection, and that the Examiner intended to indicate that claims 1, 3, 5 and 6 are rejected under § 102. {P30287 00601636.DOC}

presented 10. As such, Applicant submits that independent claims 10, 18 and 19 should be in condition for allowance.

Traversal of Objection to the Disclosure

The Examiner has objected to the disclosure because the specification lacks the proper headings and included a spelling error. By this amendment, Applicant has presented a substitute specification to address the issues raised by the Examiner. Specifically, headings have been added and minor spelling and grammatical errors have been corrected.

Accordingly, Applicant respectfully requests the objection to the disclosure be withdrawn.

Traversal of Objections to the Claims

Claims 1 – 10 have been objected to for informalities. By this amendment, Applicant has canceled claims 1 – 10 and added new claims 11 – 19. Applicant submits claims 11 – 19 have addressed the claim objections of claims 1 – 10. Specifically, Applicant has changed “cycles” to the singular “cycle,” removed “type,” and addressed the antecedent basis issues. Additionally, while Applicant does not agree with the Examiner’s assertion that “pivoting axially” is an inaccurate description of the present invention, in an effort to expedite prosecution, Applicant has replaced “pivoting” with “rotating” as the Examiner suggested.

Accordingly, Applicant respectfully requests the objections to the claims be withdrawn.

Traversal of Objection to the Drawings

The Examiner has objected to the drawings² for not showing every feature of the invention specified in the claims. Specifically, the Examiner identifies the clutch and throttle cables as not being shown in the figures. By this amendment, Applicant has amended Figure 1 two to include the clutch cable C and the throttle cable T. Applicant submits that no new matter is added by the drawing revision. Support for the amendment may be found, for example, in paragraph [0051] (as numbered in the Substitute Specification).

Accordingly, Applicant respectfully requests the drawing objection be withdrawn.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicant traverses the rejection of claims 1, 3, 5 and 6³ under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,881,750 issued to Hartmann [hereinafter HARTMANN].

To anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. Applicant submits the rejection of claims 1, 3, 5 and 6 is rendered moot by the cancellation of claims 1, 3, 5 and 6. Additionally, Applicant submits HARTMANN does not disclose all of the features of previously presented claims 3 and 6.

² Applicant notes that while the drawings were objected to in the body of the rejection, the Office Action Summary indicates that the drawings are accepted. Thus, Applicant assumes the Examiner incorrectly indicated the drawings are acceptable, and intended to indicate that the drawings were objected to.

³ As noted above in footnote 1, Applicant assumes that only claims 1, 3, 5 and 6 are rejected under §102.
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Independent Claim 1

By the present amendment, claim 1 has been canceled. As such, Applicant submits the present amendment has rendered moot the rejection of claim 1. Accordingly, Applicant requests the rejection of claim 1 be withdrawn.

Dependent Claims 3, 5 and 6

By the present amendment, claims 3, 5 and 6 have been canceled. As such, Applicant submits the present amendment has rendered moot the rejection of claims 3, 5 and 6. Accordingly, Applicant requests the rejection of claims 3, 5 and 6 be withdrawn.

Claim 3

Additionally, Applicant submits that HARTMANN does not disclose the features of previously presented and now canceled claim 3 (now presented as claim 12).

Claim 12 recites, in pertinent part:

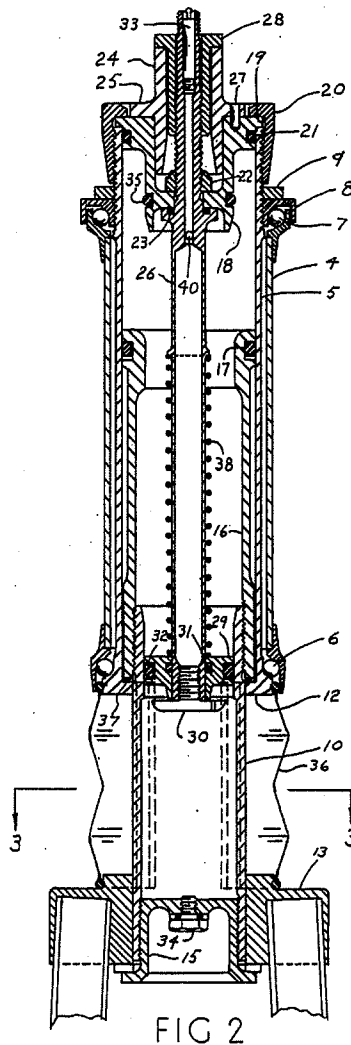
. . . a shock absorber housed between said guiding piece and the inner wall of said plunger.

In addressing previously presented claim 3 (now presented as claim 12), the Examiner asserts HARTMANN discloses:

. . . a shock absorber (generally shown as 38) is housed between said guiding piece [which the Examiner identified as 5 in addressing original claim 1] and the inner wall of said plunger [which the Examiner identified as 10 and 16 in addressing original claim 1].

Applicant respectfully disagrees.

HARTMANN discloses an all terrain bicycle shock absorber. Applicant has reproduced Figure 2 of HARTMANN below.



Applicant submits HARTMANN does not disclose a shock absorber housed between said guiding piece and the inner wall of said plunger, as recited in previously presented claim 3 (which corresponds with new claim 12). That is, as shown in Figure 2 of HARTMANN, the shock absorber is not housed between the guiding piece (which the Examiner designates as 5) and the inner wall of the plunger (which the Examiner designates as 10 and 16). Rather,

Applicant submits the shock absorber of HARTMANN is located completely within the plunger. As such, Applicant submits HARTMANN does not disclose the features of previously presented claim 3.

Accordingly, for this additional reason, Applicant respectfully requests the rejection of previously presented claim 3 be withdrawn.

Claim 6

Additionally, Applicant submits that HARTMANN does not disclose the features of previously presented and canceled claim 6 (now presented as claim 14).

Claim 14 recites, in pertinent part:

. . . wherein an inner diameter of the steering column and an outer diameter of the plunger are substantially equal.

In addressing previously presented claim 6 (now presented as claim 14), the Examiner asserts HARTMANN discloses:

. . . the inner diameter of the steering column [which the Examiner designated as 4 in addressing original claim 1] and an outer diameter of the plunger [which the Examiner identified as 10 and 16 in addressing original claim 1] are substantially equal.

Applicant respectfully disagrees.

As shown in Figure 2 of HARTMANN, reproduced above, Applicant submits the inner diameter of the head tube 4 of HARTMANN is substantially equal to neither the outer diameter of the fork tube extension 16 of HARTMANN nor the outer diameter of fork tube 10 of HARTMANN. That is, as the steering tube 5 is arranged between the head tube 4 and the fork tube extension 16, such that the head tube 4 and the fork tube extension 16 are not adjacent to

one another, Applicant respectfully submits that the inner diameter of the head tube 4 cannot be substantially equal to the outer diameter of the fork tube extension 16. Moreover, as the outer diameter of fork tube 10 is smaller than that of the fork tube extension 16, Applicant submits the inner diameter of the head tube 4 cannot be substantially equal to the outer diameter of fork tube 10.

Thus, for these additional reasons, Applicant respectfully requests the rejection of previously presented claim 6 be withdrawn.

Accordingly, for at least the above reasons, Applicant requests the rejection of claims 1, 3, 5 and 6 be withdrawn.

Traversal of Rejection Under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over HARTMANN in view of U.S. Patent 7,000,936 issued to Schmider [hereinafter SCHMIDER]. Additionally, Applicant traverses the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over HARTMANN in view of Applicant's submission.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.⁴ Second,

⁴ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 {P30287 00601636.DOC}

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant submits the rejections of claims 7 and 8 are rendered moot by the cancellation of claims 7 and 8. Additionally, Applicant submits HARTMANN in view of SCHMIDER does not teach or suggest all of the features of previously presented claim 7.

Claim 7

By this amendment, claim 7 has been canceled. As such, Applicant submits the present amendment has rendered moot the rejection of claim 7. Accordingly, Applicant requests the rejection of claim 7 be withdrawn.

Additionally, Applicant submits that HARTMANN in view of SCHMIDER does not teach or suggest the features of previously presented and now canceled claim 7 (now presented as claim 15). Claim 15 recites, in pertinent part:

. . . further comprising a front brake hose, wherein the front brake hose passes within the steering system through a central position.

In addressing previously presented claim 7, the Examiner acknowledges that HARTMANN does not teach or suggest a brake hose passes within the steering system through a central position. However, the Examiner asserts that SCHMIDER discloses a brake hose passing within the steering system through a central position, and that “it would have been obvious to one skilled in the art to modify the cycle of Harmman [sic] to include a brake hose/cable system

F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).
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passes within the steering system as taught by Schmider,” for aesthetic reasons. Applicant respectfully disagrees.

HARTMANN Teaches Away from the Examiner-Proposed Modification

Applicant notes that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, Applicant notes that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Additionally, Applicant notes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicant submits that modifying HARTMANN with the features of SCHMIDER in the manner asserted by the Examiner would change the principle of operation of HARTMANN and would render HARTMANN unsatisfactory for its intended purpose.

For example, Applicant submits that SCHMIDER teaches providing an open cable conduit such that “the control cables are able to pass through the gooseneck 2 unhindered and without interfering with the steering mechanism,” (col. 4, lines 32 – 36). As such, Applicant submits that SCHMIDER requires an open cable conduit for its control cables.

However, Applicant submits that providing an open cable conduit in HARTMANN would change the principle of operation of HARTMANN. That is, as shown in Figure 2,

reproduced above, HARTMANN does not include an open cable conduit, as components of the shock absorber occupy the head tube.

Moreover, Applicant submits providing an open cable conduit would require significant restructuring of HARTMANN, which Applicant submits would change the principal of operation of HARTMANN. For example, modifying HARTMANN to pass the cables between the fork tube extension 16 and the damper tube 26 would require significant restructuring of HARTMANN. Additionally, for example, modifying HARTMANN to pass the cables through “a central position,” as recited in previously presented claim 7, i.e., within the damper tube 26, would require significant restructuring of HARTMANN, as the damper tube 26 remains sealed to provide the damping effect.

Furthermore, Applicant submits that modifying HARTMANN with the features of SCHMIDER in the manner asserted by the Examiner would render HARTMANN unsatisfactory for its intended purpose. For example, modifying HARTMANN to pass the cables through “a central position,” as recited in previously presented claim 7, i.e., within the damper tube 26, would render HARTMANN unsatisfactory for its intended purpose of providing a dampening effect, as the damper tube 26 must remain sealed to provide the damping effect.

Thus, Applicant respectfully submits that HARTMANN teaches away from being modified in the manner asserted by the Examiner, in that the modification of HARTMANN in the manner asserted by the Examiner would change the principle of operation of HARTMANN and render HARTMANN unsatisfactory for its intended purpose. As such, Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify HARTMANN with the features of SCHMIDER in the manner asserted to arrive at the claimed invention.

Thus, Applicant respectfully submits there is no suggestion or motivation to make the proposed modification, and the Examiner has not set forth a *prima facie* case of obviousness.

Therefore, Applicant submits that HARTMANN in view of SCHMIDER does not render unpatentable the features of previously presented claim 7 (now presented as claim 15). Thus, for these additional reasons, Applicant respectfully requests the rejection of previously presented claim 7 be withdrawn.

Claim 8

By this amendment, claim 8 has been canceled. As such, Applicant submits the present amendment has rendered moot the rejection of claim 8. Accordingly, Applicant requests the rejection of claim 8 be withdrawn.

New Claims

By this amendment, Applicant has presented new claims 11 – 19. Applicant respectfully submits that these claims are in condition for allowance.

Independent Claims 11, 18 and 19

As discussed above, Applicant has placed claims 2, 4 and 10, which the Examiner indicated as containing allowable subject matter, into independent form including all of the features of the independent claim and any intervening claims. As such, Applicant submits that these claims are in condition for allowance.

Dependent Claims 12 – 17

Applicant respectfully submits that claims 12 – 17 depend from an allowable independent claim, and are allowable based upon the allowability of the independent claim, and because these claims recite additional subject matter to further define the instant invention.

Accordingly, Applicant respectfully requests the Examiner indicate that claims 11 – 19 are allowable and pass the application to issuance.

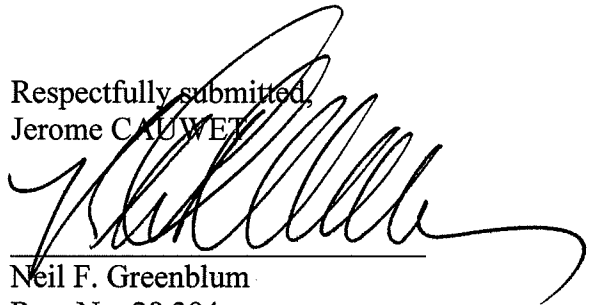
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in claims 11 – 19. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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